

REMARKS

Reconsideration and allowance of this application are respectfully requested in light of the enclosed Declaration and the following remarks.

Declaration Under 37 C.F.R 1.132

During prosecution of the parent application, in two Office Actions (mailed respectively on November 6, 2002 and July 24, 2003) , an Office Interview (conducted on September 10, 2003), and an Advisory Action (mailed on November 6, 2003), the Examiner has maintained that the cited ILOG JRules reference is an enabling teaching of means for specifying companies business rules and for a database comprising said rules, as recited by claims 1 and 20. Applicants traversed the rejection in the response to each Office Action and during the Office Interview and now provide an Declaration under 37 C.F.R. 1.132 which states *inter alia* that the cited ILOG JRules reference is not an enabling reference of means for specifying companies business rules and that it is not the case that "ordinary skill in the art would know that the rules are stored within the database" (emphasis added). Applicants also point out that in the Advisory Action the Examiner has thus admitted that the cited ILOG JRules reference does not teach that the rules are stored in a database. The Declaration provides an industry standard definition of a database and cites the paragraphs [0107] and [0108] of the present application as defining the type of database used by the present invention as being such an industry standard database and not flat files, such as those used to store XML files referred to by the Examiner in the Advisory Action.

In addition to the foregoing, the Declaration further provides evidence that none of the references cited during the prosecution of the parent application suggests or implies storing rules and roles in a database, as recited by present claims 1 and 20.

Summary of Office Interview

During the Office Interview, based on the Fianl Rejection's allegations that the cited prior art taught a replicated, distributed, database, the following is a summary of the discussion:

1. Examiner alleged that the cite ILOG JRules press release reference taught access to rules by more than one manager and therefore implied that the rules were network-accessible and did not require an explicit teaching to be cited as a reference for a networked database.
2. Examiner alleged that an explicit teaching of a database was not required in any reference cited because "Where else would you store it?" when discussing storage of roles, rules, and ads in a database as recited by the present invention of claims 1 and 20.
3. The Examiner repeatedly alleged that the present invention is a workflow application and that ILOG JRules implemented workflow.

All three of these allegations lead Applicants to the conclusions that the Examiner was reading teachings into the prior art that are not only not taught but are not even hinted by the authors of the prior art and as such are contrary to U.S. Patent Law.

The ILOG JRules reference does not teach storing business rules in a database but does teach rules are separate from the application code and that ILOG JRules itself can be embedded in Enterprise Java Beans (EJBS). Elsewhere, the cited ILOG JRules reference teaches that standard XML tools can be used to generate executable rules (page 3, line 2). These are not a teaching of a database. Further, none of the other cited references in the Office Actions of the parent application teaches a database of any kind. Applicants have pointed out and again respectfully point out that a database is a term of art that refers to a specific type of data storage that is accessible via a user interface comprising a query language. As defined in the enclosed Declaration, a database is "a sophisticated piece of software which, in addition to storing data in files (or tables), typically contains a rich set of features including meta-data (data describing the data), storage control mechanisms which control how the data is stored and where, user definition mechanisms, role definition mechanisms, access control mechanisms which restrict access to data and procedures by user and role, code triggers which fire when data is changed, and stored procedures which enforce business rules" and can be executed by a

client application. Declarant continues, "A database typically contains networking software which allows these features to be accessed remotely." No such database is even implied in any reference cited during the prosecution of the parent application.

Applicants have asserted that one ordinarily skilled in the art would perceive that the storage of data associated with each of the references cited during the prosecution of the parent application would more likely be in a commonly known file structure or a proprietary file structure and not in a database. As support, applicants cited the teaching of the cited Kashino reference (U.S. Patent No. 6,166,716) of a common PDF file structure, since Kashino is an invention concerned with editing images.

Thus, in response to the Examiner's query "Where else would you store it?" Applicants answer is a file and not a database, as claimed by present claims 1 and 20.

In order to supply the missing elements of the references, the Examiner must allege that they are either expressly taught in language other than that used in the present claims or that the claimed limitation is nonetheless inherent in the references. The Examiner has made no such allegation and there is no such other language in the cited references for networks, databases, and workflow. If the Examiner is alleging that the expression is inherent then a network, a database, and a workflow must be the one and only alternative possible and clearly this is not the case. More than one manager can access a central computer from attached terminals, a network is not required. A database is not the only storage alternative, since, as discussed, above a file structure is a more likely storage than a database and as such represents an alternative to a database.

Concerning the allegation that the present invention teaches workflow, there is no description in the present application of the present invention as a workflow application. Other than the natural sequencing that occurs because one step follows another and requires a prior step to have been completed, the present invention is not a workflow application as that term is used by one ordinarily skilled in the art. Finally, none of the present claims recite workflow related limitations.

With respect to a network, none of the cited references teaches a network, even in language different from that used in the present application. Kashino teaches a communication line, which could be a dial-up telephone line, that is used to send a PDF file. A network is not the only alternative and therefore a network is not inherent. No cited reference either explicitly or impliedly teaches a network.

Therefore, Kashino, the primary reference relied on by the Examiner in the prosecution of the parent application, lacks any teaching of a database and a network and expressly teaches away from a database by teaching a PDF file as a storage structure for the images manipulated by the teaching of Kashino.

Given the enclosed Declaration and the above discussed deficiencies of the primary Kashino reference and the secondary ILOG JRules reference, it cannot be said that these references alone or in combination with the other cited references of the parent application, established a *prima facie* case of obviousness, since the other cited references did not cure any of these already cited deficiencies.

Withdrawal of Rejection of Claim 12 as Indefinite Under 35 U.S.C. §112

A rejection of Claim 12 as indefinite Under 35 U.S.C. §112, 12 was withdrawn stating that

"...the claims will be interpreted as claiming accessing of the Ad box default templates or A Master Template and Ad Box instances, in the database, by plurality of roles associated with the Ad Box default template or Ad Master template to perform one of creating, ..."

However, Applicants respectfully pointed out that, in the claimed invention, **both**

1. accessing of the Ad box default templates in the database,
and
2. accessing of A Master Template and Ad Box instances, in the database

are being recited. It is **not** 1. **or** 2., that is, there is no alternative claiming language recited in claim 12.

ILOG JRules 3.0 Reference Is Not Enabling

Applicants have argued that the ILOG JRules press release cited during the prosecution of the parent application as prior art is not a teaching, has not been properly addressed by the Final Rejection. In response to Applicants' argument, the Final Rejection again cites a prior art reference for its unsupported statement that the ILOG JRules product (at that time not available because not yet released) simplifies business rule definition and implementation and provides sample business rule languages customizable to a specific application or industry. Again, Applicants respond that these unsupported statements, recited in the cited ILOG JRules press release, are not an enabling teaching but represent a marketing device containing exaggerated, i.e., puffing-type statements concerning capabilities of a then (at the time of the press release) as yet to be released product. That the cited ILOG JRules reference is not an enabling teach is amply supported by the enclosed Declaration.

It is well settled that prior art references must sufficiently describe the claimed invention to have placed the public in possession of it, see, e.g., *Elan Pharmaceuticals, Inc. and Athena Neurosciences, Inc., v. Mayor Foundation for medical Education and Research*, 2003 U.S. App. LEXIS 20195. Such possession is effected if one of ordinary skill in the art could have combined the publications' descriptions of the invention with his own knowledge to make the claimed invention.

Accordingly, even if the claimed invention is disclosed in a combination of printed publications, that disclosure will not suffice as prior art if it is not enabling. There is no description of the form of any ILOG JRule business rule or how one skilled in the art would incorporate such an ILOG JRule business rule into an application. There is only the statement that it would be easy to extend and customize provided sample business rule languages (which are also not taught by the cited reference) to a specific application or industry. This is not an enabling teaching. It is not even a teaching but press release hyperbole, as previously stated by Applicants. Therefore, contrary to the allegation on page 3 first paragraph of the Final Rejection of the parent application, the ILOG JRules prior art

reference does not teach means for specifying companies business rules because it discloses nothing about means for specifying business rules except that it will be easy to extend and customize provided sample business rule languages (note not the rules themselves) when they are finally released.

Furthermore, an enablement determination is made retrospectively, i.e., by looking back to the filing date of the patent application and determining whether undue experimentation would have been required to make and use the claimed invention at that time. Applicants assert that business rule technology was (and still is) relatively new and little known to persons skilled in the art of advertisement application development at the time of the invention and without a teaching of any kind in the ILOG JRules press release as to format, etc., someone ordinarily skilled in the art of advertisement application development would have had to perform undue experimentation given only the cited prior art (which includes ILOG JRules press release) in order to combine the cited prior art references to achieve the invention of claims 1-26. This is directly due to the lack of any teaching of the format of the business rules produced by the ILOG JRules reference or the definition language or any other enabling description concerning business rules in the cited ILOG JRules press release.

Definition of Business Rules

In their replies to the Office Actions filed of the parent application, Applicants refer to the definition of a business rule, provided in the ILOG JRules reference cited by the Examiner, as "statements of business policies and procedures that drive day-to-day business activity" (ILOG, page 2, line 15) as the definition being used by the Examiner. However, the Final Rejection alleges that the Examiner does not understand what definition was used in the Office Action for a business rule. Either the business rules provided by ILOG JRules are defined as "statements of business policies and procedures that drive day-to-day business activity" (ILOG, page 2, line 15) or they are not. The Examiner cannot have it both ways. If the Examiner was adopting a different definition then the Examiner should make

explicit the definition being used. The Office Actions of the parent case lack such a definition by the Examiner and the Examiner having cited a reference that provides a definition of business rules as "statements of business policies and procedures that drive day-to-day business activity" (ILOG, page 2, line 15), Applicants have justifiably concluded that this is the definition of a business rule that the Examiner has adopted and is using in the arguments made by the Examiner in the prior Office Action and in the Final Rejection.

Given this definition, the Examiner's allegation that the Kashino reference teaches preparation and administration of ads for publication by said roles *according to business rules* as recited by claim 1 is not supported because Kashino only teaches a demand which is not a business rule but is a customer's requirements that are translated by an advertisement agency for giving as instruction to a publisher so as to prepare contents of advertisement to comply with the demand (see Fig.7 and related columns). That is, the demand determines what is in the ad and is not "statements of business policies and procedures that drive day-to-day business activity" (ILOG, page 2, line 15). Nowhere in the cited reference does Kashino teach business rules according to the definition adopted by the Office Action.

Response to Prior Rejections

Applicants reiterate below their response to the rejections of the parent application, which were issued in the first Office Action maintained by the Examiner in the Final Rejection and Advisory Action of the parent application.

- I. Claims 1-4, 20, 25 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kashino (U.S. Patent No. 6,166,716, in view of ILOG JRules Software as taught by Article "New ILOG JRULES Software is First to Bring Business Rule Creation to Business People" PR Newswire; New York; Apr 5, 2000, (Hereinafter "ILOG").

The Office Action Position

The Office Action alleges that Kashino teaches company advertiser

and ad publisher personnel roles to accomplish preparation of ads for publication (col. 8 line 48 to col. 9 line 28) and preparation and administration of ads for publication by said roles according to business rules (see FIG. 7 and related columns). The Office Action admits that Kashino does not teach specifying business rules to control preparation and administration of ads for publication and storing the rules and personnel roles in a database. The Office Action alleges that ILOG teaches specifying customized business rules for specific applications or industry. The Office Action further alleges that ILOG teaches specifying business rule definition and implementation as well as workflow management, logistics and exchanges (page 1-3 of ILOG press release) The Office Action also alleges that both Kashino and ILOG teach networked, distributed and replicated database (Kashino col. 8 line 48 to col. 9 line 28 and ILOG page 3).

Applicants Response

At the outset Applicants again assert that the hyperbole of a press release is not a teaching, but a marketing device containing exaggerated, i.e., puffing-type statements concerning capabilities of a then (at the time of the press release) as yet to be released product (see pricing and availability on page 3). That this is the case is supported by (1) "Forward-Looking Information" et seq., at the bottom of page 3 and continuing on the top of page 4 of the press release as well as (2) Applicants observation that a business organization relying on a business rules application is going to have that application under strict configuration control. Strict configuration control, as practiced by anyone ordinarily skilled in the art means that changes are not made to an operational system (e.g., a business rules system) by those not ordinarily skilled in the art, as suggested by the ILOG JRules 3.0 press release. Typically, all changes are submitted to a maintenance organization that maintains the business rules application, are evaluated and approved/disapproved, implemented if approved and TESTED to insure the changes work and are compatible with existing business practices. This change implementation is never done by business analysts and end users because it would result in a non-working business rules system. So that the claim in the "New ILOG JRules Software" press release that their new capabilities bring this

technology beyond just highly skilled developers to a wider community of business analysts and end users is just hype. No organization with an investment in a business rules application is going to risk their system's integrity and operation by allowing such a wider community (of individual not ordinarily skilled in the art) to change it.

With regard to roles, at the reference cited by the Office Action (col. 8 line 48 to col. 9 line 28), (1) Kashino does not teach specifying company advertiser and ad publisher personnel roles to accomplish preparation and administration of ads for publication; and (2) Kashino does not teach any advertiser roles, both as recited by present independent Claims 1 and 20, but merely states that correcting work is done by an advertiser who participate (sic) in this publishing work (col. 9 lines 21-24). At most, Kashino teaches ad creation (editor) and correction roles (designer and copy writer) for publisher personnel (col. 9 lines 25-28).

With regard to business rules, the Office Action has provided a reference that defines business rules as "statements of business policies and procedures that drive day-to-day business activity" (ILOG, page 2, line 15). Kashino teaches at FIG. 7 and related columns, an ad preparation system comprising an advertiser who places an order for an ad with an advertisement agency that gives an *instruction to* a publishing company so as to prepare *contents of* advertisement in comply with the need of the advertiser, a publisher editor in charge prepares advertisement pages in accordance with the advertiser's demand with being helped by an external designer or copy writer, and the ad is finally sent to a *printing company* for printing. The advertiser's demand is not a business rule, according to the definition provided by the Office Action. It is a one-off requirement for a particular ad, in this case for a mail order ad in a magazine. Contrary to the allegation of the Office Action, nowhere does Kashino teach preparation and administration of ads by company advertiser and publisher personnel roles according to specified business rules, as recited by independent Claims 1 and 20. The Office Action admits that Kashino does not explicitly teach specifying the business rule of preparation and administration and personnel roles to accomplish the preparation and administration of the

advertisement and storing the rules and roles in a database. The Office Action alleges that this is taught in the Press release article for ILOG JRules Software. Applicants respectfully disagree. The cited reference, ILOG JRules Software, nowhere even mentions personnel roles much less represents a teaching of personnel roles. Further, ILOG JRules does not teach storing rules in a database as recited by Claims 1 and 20.

ILOG does not remedy any of these deficiencies of Kashino. Nowhere does the ILOG press release even mention roles or specifying roles for preparing a product and administering- the product preparation process. While the ILOG JRules 3.0 product allegedly provides a business rules engine and a business rule definition language that is customizable to a given industry, Kashino cannot be modified to employ such business rule definition language and business rules engine since Kashino does not anywhere teach employing business rules.

Regarding the allegation of the Office Action that ILOG teaches specifying business rule definition and implementation as well as workflow management, logistics and exchanges (pages 1-3), Applicants respectfully point out the ILOG press release only states "Sophisticated new features in ILOG JRules 3.0 simplify business rule definition and implementation for these applications [B2B e-business applications], as well as [for] workflow management, logistics and exchanges." The press release does not state that ILOG JRules 3.0 provides workflow management, logistics and exchanges as alleged by the Office Action.

As regards the Office Action allegation that both Kashino and ILOG teach networked, distributed and replicated databases nowhere do either Kashino or ILOG even mention distributed, replicated databases let alone networked databases. At the cited reference, Kashino only teaches a PDF file that is distributed to respective correctors using a communication line (col. 9 lines 18-21) and ILOG only states on page 3 that

"JRules 3.0 offers many features for developers that speed rule deployment and improve performance, including: ...

-- Automatic integration between the rule engine and relational databases, allowing users to define business rules that reference data stored in RDBMS (relational database management systems)."

The ILOG reference nowhere discusses networked, distributed, replicated databases, as alleged by the Office Action.

With regard to the Office Actions' allegation that it would have been obvious to one of ordinary skill to combine Kashino's publishing of ads and ILOG's software for creating business rules because one would have been motivated to implement ILOG's software to create business rules for Kashino's publishing of ads for the purpose of describing and controlling the structure, operation and strategy of the publication business. Applicants respectfully assert that since Kashino does nowhere teach the use of business rules for any purpose, let alone controlling the structure, operation and strategy of the publication business, it would not have been obvious how to modify Kashino to use ILOG's software, especially since Kashino is directed to a presentation apparatus for cooperative correction by a plurality of correctors of two-dimensional picture information and not to the structure, operation and strategy of the publication business.

Finally, Applicants assert that ILOG is a tool like a compiler or a relational database management system or a knowledge base combined with an inference engine. ILOG does not provide business rules off-the-shelf, these rules have to be defined for each business and project, see brochure for Business Rules Workshop attached hereto as Attachment #1. And, just like a tool such as a compiler or a relational database management system or a knowledge base combined with an inference engine, does not render obvious all the software and hardware inventions that use a compiler, a relational database management system, or a knowledge base combined with an inference engine, neither does ILOG render obvious all inventions that use a tool such as ILOG to define and implement business rules. The Business rules express the constraints associated with a business method/process and ILOG is just a tool for capturing business rules via a special purpose and implementing the captured business rules. The existence of a

tool does not render obvious inventions that incorporate the product of the tool. Further, the ILOG press release references other existing approaches to capturing and implementing business rules (page 1 last paragraph, page 2 paragraphs 2 and 4) which the Office Action did not cite as prior art in combination with Kashino as rendering the present invention of Claims 1 and 20 obvious. Assuming, *arguendo*, that ILOG in combination with Kashino renders the invention of Claims 1 and 20 obvious, why doesn't every other existing business rule tool do likewise? Attachment #2 hereto is a webpage <http://www.eurobizrules.org/> for a business rules conference that provides links to fifteen providers of tools for engineering business rules, including the ILOG tools cited by the Office Action.

In view of all of the foregoing discussions, the Office Action has not made out a prima facie case of obviousness, independent Claims 1 and 20 are allowable, and Claims 2-19 and 21-26, respectively dependent therefrom, are allowable for at least this reason.

II. Claims 5-19 and 21-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kashino, in view of ILOG and further in view of Johnson et al (U.S. Patent No. 6,453,301, hereinafter "Johnson").

The Office Action Position

The Office Action admitted that Kashino, as modified by ILOG, does not teach Ad Box default template defining a plurality of entries for each Ad Box instance or Ad Master template defining a plurality of components for each Ad Master instance; ... setting said status. The Office Action alleges that Johnson teaches a presentation generation system that integrates customer specific information with a selling entity element to generate a presentation item for sale of product customized for a particular customer of the selling entity (Abstract). The Office Action further alleges that Johnson teaches templates used to develop a presentation item (ad) such as programs, rules or instructions, where the templates include presentation format templates indicating the various information to be integrated to form a presentation item (ad). The presentation format template associate with

rules defining for example, the layout of a presentation item which implies that templates [are] being controlled by associated business rules and [are] being defined by at least one of company advertiser and ad publisher. Johnson further alleges that it would have been obvious to one of ordinary skill in the art to modify Kashino's publication of ads by include (sic) Johnson's templates associated with and controlled by business rules in order to quickly and easily create the presentation (ad).

Applicants Response

The customer solution system 102 taught by Johnson generates a customized presentation, not an advertisement, of available products of a selling entity to be presented to a customer that is based on the customer's requirements for those products (customer specific information) (Abstract; col. 3, lines 23-51). If a customer is seeking to buy advertising the customer solution system 102 product data may include advertisement medium, advertisement product features, advertisement length, broadcast time, broadcast coverage, etc. (col. 5, lines 53-56). FIG. 1BA-0 are examples of custom presentations for a sales proposal for advertising space in a newspaper, they are not the actual ads prepared for publication in at least one delivery medium as claimed by present claims 1-26.

The presentation system taught by Johnson supports a seller organization by generating custom presentations based on customer requirements for products sold by the sales organization. Johnson calls these presentations "proposals" because they are presented to the customers who requested them and are not published as advertisements (see, e.g., col. 2, line 2; FIG. 18A-0; FIG. 19A-P; FIG. 20A-N; col. 3, lines 29, 60, & 65; col. 4. lines 41; col. 6, lines 42 & 54).

Thus, Johnson does not cure the admitted deficiencies of Kashino. In addition, as discussed above, Kashino has several other deficiencies, and Johnson also does not cure these other deficiencies.

Therefore, the Office Action has failed to make out a *prima facie* case of obviousness and claims 5-19 and 21-24 are allowable.

Conclusion

For at least the above reasons, it is respectfully submitted that the present invention is in condition for allowance and a Notice of Allowance is respectfully requested.

Respectfully submitted,



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NOW/att
encl: Declaration under 37 C.F.R. 1.132

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